

REMARKS

This is in response to the Final Office Action mailed November 29, 2006. At the time of the Final Office Action, Claims 1-23 were pending in this Application. Claims 1-23 were rejected. Independent Claims 1, 12, and 20 have been amended to further define various features of Applicant's invention. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 12-19 were rejected in the office action under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants have amended Claim 12. The subject matter of Claim 12, and in particular, the opening and vent are supported in the application by figures 36-39 and paragraphs 00197 et seq. See, for example, reference number 918 in Figure 39A. Accordingly, the claim terms are described in the application and Applicant respectfully requests reconsideration and withdrawal of the Section 112 rejections.

Rejections Under 35 U.S.C. §103 Based On Fanton

Claims 1, 10, 13, 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,068,628 to Fanton et al. ("Fanton").

An Office Action must establish a *prima facie* case of obviousness in order to reject claims under 35 U.S.C. § 103. To establish a *prima facie* case of obviousness, at least three basic criteria must be met: 1) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02(j). In the instant case, as discussed below, one or more of the requirements for a *prima facie* case of obviousness is not met.

Independent Claim 1 recites that at least one opening extends from a first tissue contacting surface to a second surface opposite said first tissue contacting surface. The opening is also in fluid communication with an aspiration lumen. There is no suggestion or motivation to modify Fanton in order to render Claim 1 unpatentable. Fanton fails to describe an aspiration

opening, much less a tissue contacting surface having a opening that extends all the way through to an opposite surface. Also, there is nothing stated in the Office Action that suggests or provides a reason to modify Fanton in order to render the subject matter of Claim 12 unpatentable under Section 103

Independent Claim 12 likewise recites an entry port and a vent port on opposite sides of an insulating member. Unlike Claim 1, however, the insulating member is more specifically limited to a non-electrically conducting annular shaped member. Just as Fanton does not disclose or suggest the subject matter in Claim 1, Fanton does not disclose or suggest the subject matter of Claim 12. Also, there is nothing stated in the Office Action that suggests or provides a reason to modify Fanton in order to render the subject matter of Claim 12 unpatentable under Section 103.

Independent Claim 20 likewise is patentable over Fanton for the same reasons that Claims 1 and 12 are patentable over Fanton. In particular, Claim 20 recites that a suction port is in fluid communication with a vent port. This is not disclosed in Fanton as discussed above.

The other claims rejected based on Fanton are dependent on one of Claims 1, 12, or 20. Applicant submits the dependent claims are patentable over Fanton for at least the same reasons that the independent claims are patentable over Fanton.

Based on the foregoing, reconsideration and withdrawal of the rejection of Claims 1, 10, 13, 19 and 20 under Section 103 based on Fanton is requested.

Rejections Under 35 U.S.C. §103 Based On Doss

Claims 1, 2, 3, 4, 5, 6-9, 11, 12, 15 and 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,381,007 to Doss (“Doss”).

As indicated above, Claims 1 and 12 recite a distal end section comprising an opening extending from the tissue-contacting surface to a second surface opposite the tissue contacting surface. A non-limiting example is shown in the application at Figures 37-39, and the corresponding text. This claim limitation is not disclosed, nor suggested, in Doss.

The Office Action, at page 5, makes reference to a void connecting two ports in figure 1 of Doss. However, the two ports are not positioned on opposite sides of the distal end. The ports shown in Doss are both in the same plane. Consequently, Doss does not disclose or suggest a

side opposite to the tissue-contacting surface which is fluidly connected to an aspiration lumen. Based on the foregoing, Applicant submits that Doss does not render Claims 1 or 12 unpatentable under Section 103.

The other claims rejected based on Doss are dependent on one of Claims 1 or 12. Applicant submits the dependent claims are patentable over Doss for at least the same reasons that the independent claims are patentable over Doss.

Based on the foregoing, reconsideration and withdrawal of the rejection of Claims 1, 2, 3, 4, 5, 6-9, 11, 12, 15 and 16-18 under Section 103 based on Doss is requested.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 408.735.6323.

Additionally, the Commissioner is hereby authorized to charge any fees necessary to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

Respectfully submitted,



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